

K-C Docket No.: 17,858.3  
Serial No.: 10/749,988  
December 14, 2006  
Reply to Office Action of October 25, 2006

### **Remarks**

Claims 1-26 are pending in the instant application. Claims 6, 7, and 16 have been withdrawn. Claims 1-5, 8-14, and 16-26 form the subject matter of this response. Pursuant to 37 C.F.R. § 1.116, reconsideration of the present application in view of the following remarks is respectfully requested.

By way of the Office Action mailed October 25, 2006, claims 1-5 and 21-24 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated, and thus unpatentable, over Tubo et al. (US 5,040,677) (hereinafter "Tubo"). Claims 11-14 and 16 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by, and thus unpatentable over, Narawa et al. (JP 10-95481) (hereinafter "Narawa"). Claims 8, 10, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tubo in view of Narawa et al. (JP 10-95481) (hereinafter "Narawa"). Claims 11-14 and 20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tubo in view of Hahn et al. (US 4,801,005) (hereinafter "Hahn"). Claim 16 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tubo in view of Hahn and further in view of Narawa. Claims 9, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tubo in view of Hahn and further in view of Franks-Farah et al. (US 6,640,976) (hereinafter "Franks-Farah"). Claim 19 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tubo in view of Hahn, in view of Frank-Farah, and further in view of Official Notice. These rejections are respectfully **traversed** to the extent that they may apply to the presently presented claims.

### **Rejections Under 35 U.S.C. § 102**

#### **Tubo does not disclose each and every element of the claimed invention.**

By way of the Office Action mailed October 25, 2006, the Examiner rejects claims 1-5 and 21-24 under 35 U.S.C. § 102(b) as allegedly being anticipated, and thus unpatentable, over Tubo. This rejection is respectfully **traversed**.

When asserting a Section 102 rejection, it is well established that there is no anticipation unless (1) all the same elements are (2) found in exactly the same situation and (3) are united in the same way to (4) perform the identical function. Independent claims 1, 11, and 21 (and thus also their dependent claims) each include at least one element not found in Tubo (or the other art of record), namely, a package enclosing a single disposable absorbent article of the subject invention. The Examiner states that the skin wound dressing of Tubo "is inherently capable to absorb and dispose which is considered equivalent to the disposable absorbent article as claimed." Tubo discloses a "skin wound dressing" made up of a cultured human epithelial cell sheet stapled to petroleum jelly-impregnated gauze. See,

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e.g., col. 3, lines 37-46. There is nothing absorbent or disposable about Tubo's wound dressing. Tubo's wound dressing is not the bandage apparently envisioned by the Examiner, but it is instead a layer of human skin cells attached to a carrier substrate. As such, the wound dressing is certainly not disposable. In addition, the substrate is impregnated with petrolatum precisely so it is not absorbent. This arrangement prevents the layer of skin cells from sticking to the substrate. Applicants respectfully invite the Examiner to highlight the portions of the Tubo disclosure that describe how the Tubo wound dressing "is inherently capable to absorb and dispose." With at least this element lacking from the teaching of Tubo, the presented claims cannot be anticipated by Tubo. Therefore, the rejection of independent claims 1, 11, and 21 (as well as their respective dependent claims) is respectfully requested to be withdrawn.

### **Rejections Under 35 U.S.C. § 103**

#### **Tubo in view of Narawa does not make obvious the claimed invention.**

Claims 8, 10, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tubo in view of Narawa. This rejection is respectfully **traversed**.

The Examiner's "Response to Arguments" with respect to this rejection appears to miss the point. The Examiner states that one would look to Narawa for a compact package that may or may not be vacuum packed. But the Examiner in paragraph 4 uses Narawa for the specific purpose of introducing vacuum packing. Such an addition of vacuum packing to Tubo could lead to catastrophic results as further explained below. In addition, Narawa contributes nothing to the Examiner's combination with respect to the subject matter of claims 10 and 26.

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143.

First, there is no motivation or suggestion in Tubo for one of skill in the art to modify the Tubo disclosure to achieve the claimed invention, and the Examiner has not described any practical motivation or suggestion outside of Tubo, such as in general knowledge, to do so. The Examiner states without evidence that vacuum packing Tubo's wound dressing would better protect the wound dressing and would provide for a smaller package such that vacuum packing is desirable. Skin cells and the saline or culture medium in which they are stored do not do well in the lack of oxygen and

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pressure inherent to a vacuum (e.g. liquids can boil at room temperature in a vacuum). Vacuum packing of such is completely undesirable, thus eliminating any motivation or suggestion to do so.

Second, the Examiner has not described in any manner how or even if there might be a reasonable expectation of success in modifying Tubo, where in fact there appears to be more of a reasonable expectation of disaster.

In the alternative, claims 8, 10, 25, and 26 all depend from allowable independent claims as described above and are thus allowable themselves.

Therefore, for at least these reasons, the rejection of claims 8, 10, 25, and 26 is respectfully requested to be withdrawn.

Tubo in view of Hahn do not make obvious the claimed invention.

Claims 11-14 and 20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tubo in view of Hahn. This rejection is respectfully traversed.

Neither Tubo nor Hahn alone or together teach or suggest all the claim limitations of claims 11-14 or 20 as required by MPEP §2143. Hahn teaches a pleated rubber-and-cardboard matt used to catch oil during an automobile oil change. The matt may be re-folded and reinserted into its original package.

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143.

First, there is no motivation or suggestion in either Tubo or Hahn for one of skill in the art to modify the Tubo disclosure to achieve the claimed invention, and the Examiner has not described any practical motivation or suggestion outside of Tubo or Hahn, such as in general knowledge, to do so. Second, the Examiner has not described in any manner how or even if there might be a reasonable expectation of success in modifying Tubo or Hahn. Tubo has no need of a pleated or folded product, an absorbent product, or a recloseable package. Hahn has no need for a layer of skin cells or a package that can't be reclosed. There is nothing Tubo could gain or improve with reference to Hahn, and there is nothing Hahn could gain or improve with reference to Tubo. To the contrary, it is readily apparent that when each cited reference is considered in its entirety and taken as a whole, a proper combination of the cited references would not teach the Applicant's claimed invention. Only in light of the Applicant's

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present disclosure and the impermissible use of hindsight would a person of ordinary skill be directed to the significant changes and modifications needed to reconfigure the various components of both references to arrive at Applicant's claimed invention. As such, the invention called for by Applicant's claims is patentable over the cited references.

Therefore, for at least these reasons, the rejection of claims 11-14 and 20 is respectfully requested to be withdrawn.

Tubo in view of Hahn and further in view of Narawa do not make obvious the claimed invention.

Claim 16 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tubo in view of Hahn and further in view of Narawa. This rejection is respectfully traversed.

Neither Tubo nor Hahn nor Narawa alone or together teach or suggest all the claim limitations of claim 16 as required by MPEP §2143.

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143.

First, as discussed above with reference to claims 11-14 and 20, there is no motivation or suggestion in either Tubo or Hahn for one of skill in the art to modify the Tubo disclosure to achieve the claimed invention, and the Examiner has not described any practical motivation or suggestion outside of Tubo or Hahn, such as in general knowledge, to do so. Second, the Examiner has not described in any manner how or even if there might be a reasonable expectation of success in modifying Tubo or Hahn. Tubo has no need of a pleated or folded product, an absorbent product, or a recloseable package. Hahn has no need for a layer of skin cells or a package that can't be reclosed. There is nothing Tubo could gain or improve with reference to Hahn, and there is nothing Hahn could gain or improve with reference to Tubo. Narawa doesn't remedy this situation. To the contrary, it is readily apparent that when each cited reference is considered in its entirety and taken as a whole, a proper combination of the cited references would not teach the Applicant's claimed invention. Only in light of the Applicant's present disclosure and the impermissible use of hindsight would a person of ordinary skill be directed to the significant changes and modifications needed to reconfigure the various components of both references to arrive at Applicant's claimed invention. As such, the invention called for by Applicant's claims is patentable over the cited references.

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In the alternative, claim 16 depends from an allowable independent claim as described above and is thus allowable itself.

Therefore, for at least these reasons, the rejection of claim 16 is respectfully requested to be withdrawn.

Tube in view of Franks-Farah do not make obvious the claimed invention.

Claims 9, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tube in view of Hahn and further in view of Franks-Farah. This rejection is respectfully **traversed**.

Referring to the Examiner's "Response to Arguments," it is unclear to what "printed matter" the Examiner refers in saying that printed matter teaching a new use does not impart patentability. Because claims 9, 17, and 18 make no reference to printed matter, the Examiner's response appears to be misdirected.

Neither Tube nor Hahn nor Franks-Farah alone or together teach or suggest all the claim limitations of claims 9, 17, or 18 as required by MPEP §2143. Franks-Farah teaches only including color-coding in step-by-step instructions to assist a user in identifying corresponding components of a kit. Tube and Hahn teach even less. Instructions are quite different from an opening element. No reference or combination of references discloses, teaches, or suggests an opening element coded to indicate the size or type of an absorbent article. In addition, the questionable combination of these references is discussed in more detail above. Only in light of the Applicant's present disclosure and the impermissible use of hindsight would a person of ordinary skill be directed to the significant changes and modifications needed to reconfigure the various components of both references to arrive at Applicant's claimed invention. As such, the invention called for by Applicant's claims is patentable over the cited references.

In the alternative, claims 9, 17, and 18 all depend from allowable independent claims as described above and are thus allowable themselves.

Therefore, for at least these reasons, the rejection of claims 9, 17, and 18 is respectfully requested to be withdrawn.

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Tubo in view of Hahn, Franks-Farah, and the Official Notice do not make obvious the claimed invention.

Claim 19 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tubo in view Hahn, Franks-Farah, and further in view of Official Notice

Neither Tubo nor Hahn nor Franks-Farah nor the Official Notice alone or together teach or suggest all the claim limitations of claim 19 as required by MPEP §2143. Franks-Farah teaches only including color-coding in step-by-step instructions to assist a user in identifying corresponding components of a kit. Tubo teaches even less, and the Official Notice does not correct these deficiencies. Instructions are quite different from an opening element. No reference or combination of references discloses, teaches, or suggests an opening element coded to indicate the size or type of an absorbent article.

In the alternative, claims 19 depends from an allowable independent claim as described above and is thus allowable itself.

Therefore, for at least these reasons, the rejection of claim 19 is respectfully requested to be withdrawn.

For the reasons stated above, it is respectfully submitted that all of the presently presented claims are in form for allowance.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: (920) 721-8863.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-8300 on December 14, 2006.

  
Mary L. Marchant